

Remarks

Reconsideration of the above-identified application in view of the present amendment and the following remarks is respectfully requested.

The present Amendment was not earlier presented because the Applicants believe that the prior Amendment had placed the application in a condition for allowance. The present Amendment does not raise any new issues and does not require further searching on the part of the Examiner. It is believed that the present Amendment places the application in condition for allowance. Entry is therefore solicited.

Claims 1-20 are pending in the application. No amendments to the application has been made by this paper.

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,204,209 to Rozek et al., hereinafter "*Rozek*" in view of U.S. Patent No. 5,977,244 to Kohlhammer et al., hereinafter "*Kohlhammer*". Claims 19-20, which were added by the previous amendment, were also rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rozek* in view of *Kohlhammer*. Applicant respectfully traverses these rejections.

The law is clear that a patent is to be granted unless the Examiner can establish that the invention would have been obvious at the time it was made. The Examiner fails this burden. The suggestion to combine the references, required by the law, is missing.

The Examiner acknowledges that neither *Rozek* nor *Kohlhammer*, alone, disclose, teach or suggest the present invention. The Examiner combines *Rozek* with *Kohlhammer* stating that:

Rozek et al., meets the structural limitations. Since it has been established that *Rozek et al.* teaches using binder to bond the fiber together at points of intersection as well as to adhere the

fibrous reinforcing mats 16, 18, and 20 to adjacent layers 12, 14, and 22 and since the particular binder of *Rozek et al.*, is not critical to the acoustical composite headliner, it is the position of the Examiner that it is proper to look to the prior art for suitable binders that are advantageous to use.

* * *

Kohlhammer et al., specifically teaches that powdered textile binder is useful to produce laminates and/or semi-finished products for the production of moldings from fibrous material (Column 4, 64- Column 5, 1-18). The motivation to use such a binder as taught is found in the disclosure of *Kohlhammer et al.*, which teaches that powdered binders offer several advantages over aqueous binders such as eliminating the energy-intensive drying step and the wastewater treatment (Column 5, 21-30).

Thus, the Examiner maintains that proper motivation exists to combine the above aforementioned references to meet the structural and chemical limitations of the instant invention.

(January 30, 2004 Office Action, Page 3 and 4.) (Emphasis is added.)

Applicants, however, respectfully disagree with these assertions. There is no motivation in the prior art to combine *Rozek* with *Kohlhammer* to teach the present invention. Specifically, the Examiner's assertion that "it is proper to look to the prior art for suitable binders that are advantageous to use" is not the proper standard to use for an obviousness rejection. There must be motivation for *Rozek* to look to another reference. Furthermore, the motivation must be found in the prior art. As set forth in more detail below, the Examiner has not provided any of the requisite evidence of a suggestion for *Rozek* to look to the teaching of *Kohlhammer*.

The law requires that there be some teaching, suggestion, or motivation to combine *Rozek* with *Kohlhammer*. *In Rouffet*, 37 USPQ 2d, 1453, 1456 (Fed. Cir. 1998).¹ Otherwise, the Examiner is impermissibly engaging in hindsight to evaluate the invention:

If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements, would permit an Examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.”

(*Rouffet*, 47 USPQ 2d, 1457, quoting *Sensonics, Inc. v. Aerisonic Corp.*, 38 USPQ 2d, 1551, 1554 (Fed. Cir. 1996) (Emphasis added.).

To prevent the use of hindsight based on the invention, the law requires the Examiner to show a motivation to combine the references. Furthermore, as set forth in the CAFC case of *In re Anita Dembiczak and Benson Zinbarg*, 50 USPQ 2d, 1614 (Fed. Cir. 1999), the requirements for showing the motivation to combine references is “rigorous.” *Dembiczak* at 1617.

The Examiner has failed to show the requisite motivation to combine the references because none exist.

Rozek is directed to a thermoformed contoured three-dimensional laminated structure having improved sound absorbing characteristics. As the Examiner pointed out, one of the limitations on *Rozek*’s binder selection is that it not be present in such an amount as to interfere excessively with porosity. (Column 3, lines 52-56.) This is because it is the focus of *Rozek* to provide a headliner having substantially improved sound absorbing characteristics.

¹ For the Examiner’s convenience, copies of the cited references are attached herewith.

Rozek does so by providing a porous fibrous layer and a porous rigid foam layer. (Column 1, line 65 to Column 2, line 8.) To insure that porosity is not interfered with, the fibers of the fibrous batt 12 are bound together only at the points of intersection. (Column 3, lines 52-56.) To insure that the fibers are only bound together at the points of intersection, *Rozek* employs the use of a water based binder. (Column 4, lines 4-6.) As such, *Rozek* would never be motivated to look to a disclosure, such as *Kohlhammer's*, that incorporates a non-water based binder. The water based binder is important in *Rozek* because it insures that only the points of intersection are bonded. The water based binders will only maintain contact with the fibers and as such the use of the water based binders will insure that only the intersections of the binders are bonded.

The Examiner's assertion that it is proper for *Rozek* to look to the prior art for suitable binders is improper. Furthermore, the Examiner has failed to provide any motivation for *Rozek* to look to alternative types of binders than the ones he suggests. *Rozek* has no incentive to look to any alternative type of binder. There is no suggestion in *Rozek* that he believes there is any deficiency with any of the binder materials he identifies.

There is no reason for *Rozek* to look outside his own disclosure for any suitable binders. He lists several sufficient water based binders that can be used. Nowhere in his teachings does he suggest that any other type of binders could be used nor does he suggest that there may be any deficiencies with the binders he suggests. In fact, in stating that the binders are to be sufficient only to bond the fibers at points of intersection, *Rozek* has taught away from the use of a solid powdered binder. Solid powdered binders such as the ones taught in *Kohlhammer*, would no insure that porosity is not excessively interfered with. This is because the powdered solid binders can become disposed in the spaces between the fibers, unlike the liquid binders disclosed in *Rozek*.

As discussed above, the requirement for the Examiner to show a motivation to combine the references is not easily satisfied. To the contrary, the requirements for showing the motivation to combine references is "rigorous" and the showing of the motivation must be

shown to be “clear and particular.” *Dembiczak* at 1617. See also, *C.R. Bard v. M3 Sys., Inc.*, 48 USPQ 2d, 1225, 1232 (Fed. Cir. 1998). It is well established that merely because references can be combined, the mere suitability for logical combination does not provide motivation for the combination. See, *Berghauser v. Dann*, Comr. Pats., 204 USPQ 393 (DCDC 1978); *ACS Hospital Systems, Inc., v. Montefiore Hospital*, 221 USPQ 929 (Fed. Cir. 1984). Moreover, mere conclusory statements supporting the proposed combination, standing alone, are not “evidence.” *McElmurry v. Arkansas Power & Light Co.*, 27 USPQ 2d, 1129, 1131 (Fed. Cir. 1993) (Emphasis added).

This appears to be the exact situation here. Only conclusory statements, such as that it is “proper to look” and that “proper motivation exists”, have been offered. There certainly has not been any clear and particular showing of the necessary suggestion in the prior art to combine the references. Such a conclusory statement suggests that the applicant’s own claims have been impermissibly used as a template to reconstruct the rejection.

The Federal Circuit had stated over and over again, hindsight must not be used to construct a rejection.

The combination of elements...in the manner that reconstructs the applicants invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from applicants invention itself.

In re Oetiker, 24 USPQ 2d, 1443, 1446 (Fed. Cir. 1992).

The Board of Patent Appeals and Interferences has spoken to the type of rejection that has been set forth here, in *Ex parte Clapp*.

In the instant application, the Examiner has done a little more than cite references to show that one or more elements or sub-combinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements.... To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing letter reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.... Based upon the record before us, we are convinced that the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide. It is noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.

Ex parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d, 1780, 1783-1784 (Fed. Cir. 1992). (Emphasis added.)

There is no such suggestion here. Neither *Rozek* nor *Kohlhammer* suggest any motivation to combine these two references. As a result, the Examiner has failed to state any, let alone the proper, motivation to combine these two references

Furthermore, there is no expectation of success in combining the binders used in *Kohlhammer* with *Rozek*. As discussed above, *Rozek* teaches away from the use of a solid powdered binder. Furthermore, *Kohlhammer* is directed to powdered crosslinkable textile binder compositions. The binder composition in *Kohlhammer* is for use with textiles. To begin with, there is no indication that a binder useable for thin textiles would be suitable for the types of fibrous mats anticipated in *Rozek*. The fibrous mats in *Rozek* are quite different from the textile fabrics of *Kohlhammer*. The fibrous mats of *Rozek* are used for a headliner and must have sufficient structural rigidity for that purpose. One of ordinary skill in the art would not expect the crosslinkable binders for use with a textile to be applicable to the type of binders needed for *Rozek*.

Furthermore, the crosslinkable binder in *Kohlhammer* comprises a second component i.e., at least one part compound having two or more epoxide or isocyanate groups and a melting point of 40 to 150°C. One such type of suitable crosslinker comprises bisphenol A. (Column 3, lines 45-47.) The binder taught in *Kohlhammer* is entirely different from the acrylic polystyrene copolymer claimed by the present invention.

Accordingly, the combination of *Rozek* with *Kohlhammer* is improper and the rejection should be withdrawn.

Applicant submits that the claims are in a condition for allowance and respectfully requests a notice to that effect. If the Examiner believes that a telephone conference will advance the prosecution of the application, such a conference is invited at the convenience of the Examiner.

Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

FREDERICK L. HJORTSBERG

By


Michael S. Brodbine
Reg. No. 38,392
Attorney for Applicant

Date: March 25, 2004

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351